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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,266	10/24/2003	Anne M. Lia		9076

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EXAMINER

FLOOD, MICHELE C

ART UNIT PAPER NUMBER

1654

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/693,266

Applicant(s)

LIA, ANNE M.

Examiner

Michele Flood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed October 24, 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The information disclosure statement filed October 24, 2003 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of Claim 1, line 1, are rendered vague and indefinite by the phrase "plain isopropyl alcohol" because it is unclear as to what Applicant considers as "plain alcohol". For example, it is known in the art that isopropyl alcohol is commercially available as a clear liquid having various grades of concentrations of 91%, 95% and 99% of the alcohol, as well as rubbing alcohol that generally contains about 10%-70% isopropyl alcohol. Thus, the recitation of the phrase "plain isopropyl alcohol" in Claim 1 fails to particularly point out and distinctly point out the subject matter Applicant intends to direct the subject matter of the instantly claimed invention.

The metes and bounds of Claim 1, line 2, are rendered vague and indefinite by the phrase "a. 70% to 91% isopropyl alcohol" because it is unclear as to the subject matter Applicant intends to direct the instantly claimed invention. For example, does "70% to 91%" refer to the percentage weight amount of the isopropyl alcohol contained therein the claimed composition or does it refer to the percent volume or grade of isopropyl alcohol contained therein the claimed composition? The lack of clarity renders the claim ambiguous.

Claim 1 recites the limitation "the addition", in line 4. There is insufficient antecedent basis for this limitation in the claim. Applicant may overcome the rejection by replacing "the addition" with adding.

Claim 1 recites the limitation "the resulting solution", in line 6. There is insufficient antecedent basis for this limitation in the claim.

Although not rising to the level of uncertainty, Claim 1, as drafted, is not deemed complete because the claim merely lists 3 ingredients comprising the instantly claimed invention versus the listing of three ingredients together. Applicant may overcome the rejection by adding and, after "oil" in line 3 of Claim 1.

Claim 2 recites the limitation "the potency" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the resulting solution", in line 3. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Lia (\*A).

Applicant claims an improvement on plain isopropyl alcohol containing: a. 70% to 91% isopropyl alcohol, b. pure, natural peppermint oil, and, c. natural pink coloring produced by adding and blending in of FD&C red and FD&C blue liquid colorings, whereby the resulting solution may be used for stimulating, freshening, cooling, itch-relieving, and deodorizing properties not characteristic of plain alcohol, and may be distinguished by its color from plain alcohol and wintergreen alcohol. Applicant claims an improvement on natural peppermint oil containing: a. an isopropyl alcohol solvent that dilutes and reduces the potency of peppermint oil, whereby the resulting solution is a non-oily, antimicrobial peppermint therapy for feet, body, hair and scalp, and a deodorizing, sanitizing and fragrant cleanser for the insides of shoes, toilet seats, telephones and other surfaces.

Lia teaches each of the claimed inventions. See entire document.

The reference anticipates the claimed subject matter.

Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Hawley (U), Chemical Profiles (V, [http://www.scorecard.org/chemical-profiles/html/isopropyl\\_alcohol.html](http://www.scorecard.org/chemical-profiles/html/isopropyl_alcohol.html)) and Schmolka (\*B).

Applicant's claimed invention was set forth above.

Hawley teaches isopropyl alcohol as a colorless liquid with a pleasant odor.

Hawley further teaches isopropyl alcohol as a solvent for essential oils.

Chemical Profiles teaches that isopropyl alcohol is registered as an antimicrobial, bactericide, fungicide and virucide, which is used for sterilizing and disinfecting

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surfaces. Chemical Profiles further teaches as a colorless liquid with an alcoholic odor and a bitter taste.

Neither Hawley nor Chemical Profiles expressly teach isopropyl alcohol as a solvent having the claimed functional effects for diluting and reducing the potency of peppermint oil. However, the composition taught by Hawley and Chemical Profiles is the one and the same isopropyl alcohol as instantly claimed by Applicant. Therefore, the functional effects are inherent to isopropyl alcohol. Please note that the claim, as drafted, merely reads on an isopropyl alcohol solvent.

Schmolka teaches a composition containing isopropyl alcohol and peppermint oil. In Column 5, line 67 to Column 6, line 4, Schmolka further teaches adding a coloring agent to the referenced composition. See patent claims. Schmolka teaches that the object of the referenced invention is the elimination of the problems in a mouthwash composition associated with solubilizing a flavoring oil, particularly peppermint oil, so as to avoid reduced clarity at ambient temperatures and below, in Column 2, lines 36-40. Isopropyl alcohol is used as a solubilizing agent to solubilize peppermint oil in the making of the composition taught by Schmolka.

Each of the references or Hawley, Chemical Profiles and Schmolka anticipates the claimed subject matter.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley (U) and Chemical Profiles (V) in view of Schmolka (B\*) and Winter (W).

Hawley teaches isopropyl alcohol as a colorless liquid with a pleasant odor. Hawley further teaches isopropyl alcohol as a solvent for essential oils. Chemical Profiles also teaches isopropyl alcohol as a solvent for essential oils. As evidenced by Chemical Profiles, isopropyl alcohol is registered as an antimicrobial, bactericide, fungicide and virucide that is used for sterilizing and disinfecting surfaces. Isopropyl alcohol is commercially available in various grades, wherein isopropyl alcohol is present at concentrations of 91%, 95% and 99% (nanograde) of the total weight of the composition.

The teachings of Hawley and Chemical Profiles are set forth above. Neither Hawley nor Chemical Profiles teach isopropyl alcohol containing 70% to 91% isopropyl alcohol, peppermint oil and the claim-designated colorants. However, it would have been obvious to one of ordinary skill in the art to add the instantly claimed ingredients to the isopropyl alcohol taught by either Hawley or Chemical Profiles to provide an improvement on plain isopropyl alcohol because at the time the invention was made it was known in the art that the addition of peppermint oil and colorants to



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isopropyl alcohol was beneficial in the making of solutions having the claim-designated functional properties, as evidenced by the teachings of Schmolka and Winter. Firstly, Schmolka teaches a composition containing isopropyl alcohol and peppermint oil. See patent claims. In Column 5, line 67 to Column 6, line 4, Schmolka further teaches adding a coloring agent to the referenced composition. Schmolka further teaches a method of preparing oral preparations including mouthwashes and dentrifices which are free from unpleasant, bitter surfactant taste and are stable, visually clear and haze free at ambient temperatures by employing nonionic surfactant solubilizing agent especially effective with peppermint flavoring oil, in Column 1, lines 51- 57. Schmolka also teaches that the object of the referenced invention is the elimination of the problems in a mouthwash composition associated with solubilizing a flavoring oil, particularly peppermint oil, so as to avoid reduced clarity at ambient temperatures and below, in Column 2, lines 36-40. The mouthwash compositions taught by Schmolka contain water and a nontoxic alcohol such as isopropanol or ethanol, as set forth in Column 4, lines 13-18. Secondly, Winter teaches that the claim-designated liquid colorings are useful additives to color cosmetic or ingestible or food compositions. At the time the invention was made, one of ordinary skill in the art would have been motivated and one would have had a reasonable expectation of success to add peppermint oil to the isopropyl alcohol taught by either Hawley or Chemical Profiles to provide the instantly claimed improvement on isopropyl alcohol because Schmolka teaches that the addition of peppermint oil to a nontoxic alcohol, such as isopropanol, is useful in the making of mouthwash or dentrifice compositions without a bitter taste due to the flavoring property

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of the peppermint oil, and that the addition of isopropyl alcohol to peppermint oil solubilizes the water-insoluble flavoring oil so as to prevent cloudiness and haze at ambient temperatures and temperatures below ambient temperatures; and, Winter teaches that FD&C red and FD&C blue liquid colorings are commonly used in the coloring of cosmetics, food and drug products.

With regard to the claim-designated limitation of the improvement on plain isopropyl containing 70% to 91% isopropyl alcohol, it would have been merely a matter of judicious selection for one of ordinary skill in the art at the time the invention was made to use 70% to 91% isopropyl alcohol in the making of an improvement on plain isopropyl alcohol, as it is well known in the art that solutions having therapeutic beneficial properties are conventionally prepared using 70% to 91% isopropyl alcohol, as evidenced by the teachings of Hawley and Chemical Profiles, wherein the isopropyl alcohol serves as a solvent for essential oils, such as the peppermint taught by Schmolka.

With regard to the claim-limitation of a natural pink coloring produced by the addition and blending in of FD&C red and FD&C blue liquid colorings, it would have been merely a matter of judicial selection for one of ordinary skill in the art to pick and choose which coloring agent(s) to add to the composition taught by Schmolka because Schmolka teaches that coloring agents can be used in the making of the referenced composition and Winter teaches that the claim-designated coloring agents are useful in the making of cosmetic and food compositions, drug products. Moreover, the adding and blending of coloring agents to a colorless composition to provide a pink natural

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coloring to distinguish it from another colored or colorless composition, such as plain alcohol or wintergreen alcohol, would have been no more than a matter of judicious selection to one practicing the invention at the time the invention was made because the distinguishing of one composition one from the other can be effected by other means, such as labeling of the composition or the addition of other coloring agents that would provide a coloring to the solution other than a natural pink coloring, as instantly claimed by Applicant.

Accordingly, the claimed invention was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, especially in the absence of evidence to the contrary.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1 and 2 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 2 of copending Application No. 10/271,905. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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\* Applicant is advised that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. Should you receive inquiries about the use of the Office's PAIR system, applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is 571-272-0964. The examiner can normally be reached on 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**MICHELE FLOOD**  
**PRIMARY EXAMINER**

Michele Flood  
Examiner  
Art Unit 1654

MCF  
May 25, 2005